

REMARKS

Reconsideration of the subject application is requested in view of the foregoing amendments and the following remarks. Claims 1-28 are pending in the application, with claim 1 being independent.

Statutory double-patenting rejections

Claim 1 has been provisionally rejected under 35 U.S.C. §101 in view of claim 1 of U.S. Application Ser. No. 10/826,260 (now U.S. Patent No. 7,071,692) and claim 29 of U.S. Application Ser. No. 09/985,473 (now abandoned). These rejections are respectfully traversed.

The parent '473 application is abandoned and therefore cannot serve as the basis of a double patenting rejection. Accordingly, the rejection in view of the parent '473 application is moot and should be withdrawn.

Applicants submit that the rejection in view of Application Ser. No. 10/826,260 (now U.S. Patent No. 7,071,692) is improper. The present application was filed in response to a restriction requirement issued in the parent '473 application. Application Ser. No. 10/826,260 (now U.S. Patent No. 7,071,692), Application Ser. No. 10/826,321, and the present application are the three divisional applications filed as a result of the restriction requirement made by the Patent Office. Applicants submit that a double-patenting rejection is prohibited in the present situation. As discussed in MPEP §804 and §804.01, under 35 U.S.C. §121, a prohibition against double-patenting rejections applies where the Patent Office has made a requirement for restriction. The prohibition applies to divisional applications not voluntarily filed by the applicant, but rather filed in response to a Patent Office requirement for restriction. 35 U.S.C. §121 states in part, "[a] patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, shall not be used as a reference either in the Patent and Trademark Office or in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application." Accordingly, Applicants submit that the statutory double-patenting rejection of

claim 1 over Application Ser. No. 10/826,260 (now U.S. Patent No. 7,071,692) cannot properly be maintained.

Applicants further note that claim 1 of U.S. Patent No. 7,071,692 recites an apparatus for use in RF shielding, comprising a holder comprising RF shielding and configured for adjoining a magnet comprising magnet-RF-shielding. In contrast, claim 1 of the present application recites a method of providing RF shielding, comprising placing the patient on a holder. The act of “placing the patient on a holder” is a positively recited element of claim 1 of the present application that is lacking from claim 1 of U.S. Patent No. 7,071,692. The presence of the “placing the patient on a holder” element renders claim 1 of the present application more than “merely different in form or content” and constitutes a “patentable distinction” over claim 1 of U.S. Patent No. 7,071,692. MPEP 804.03.

Furthermore, since the present application and U.S. Patent No. 7,071,692 (which issued from an application related to the present application) share the same effective filing date, the common owner of the present application and U.S. Patent No. 7,071,692 would in any case not obtain “two or more patents with different expiration dates” with the allowance of the present application. MPEP 804.03.

Applicants respectfully request that the statutory double-patenting rejections of claim 1 be reconsidered and withdrawn in view of the above remarks.

Non-statutory double-patenting rejections

Claims 8, 9, 22, and 23 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 2-6 of Application Ser. No. 10/826,260 (now U.S. Patent No. 7,071,692). Claims 2-28 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 30-60 of the parent ‘473 application.

As discussed above, the parent '473 application is abandoned and therefore cannot serve as the basis of a double patenting rejection. Accordingly, the rejection in view of the parent '473 application is moot and should be withdrawn.

Without conceding the propriety of the rejection over U.S. Patent No. 7,071,692, and in order to expedite prosecution of the present application, Applicants agree to submit an appropriate terminal disclaimer to obviate this rejection.

The filing of a terminal disclaimer to obviate a rejection based on nonstatutory double patenting is not an admission of the propriety of the rejection. *Quad Environmental Technologies Corp. v. Union Sanitary District*, 946 F.2d 870 (Fed. Cir. 1991). The filing of a terminal disclaimer serves the statutory function of removing the rejection of double patenting, and raises neither a presumption nor estoppel on the merits of the rejection. *Id.*; MPEP 804.02. Once the terminal disclaimer is submitted, Applicants respectfully submit that the obviousness-type double patenting rejection in view of U.S. Patent No. 7,071,692 should be withdrawn.

Rejection under 35 U.S.C. §103

Claims 1-28 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,735,278 ("Hoult") in view of U.S. Patent No. 5,012,217 ("Palkovich"). This rejection is respectfully traversed.

Claim 1 recites a method of providing RF shielding comprising placing a patient on a holder, wherein the holder comprises RF shielding and is configured for forming a substantially complete RF shield around the patient when the holder is adjoined to the cavity of a magnet associated with magnet-RF-shielding.

The Hoult patent, which relates to a surgical procedure with magnetic resonance imaging, discloses RF shielding for a magnet 14 in the following arrangement: a layer 71 is applied on the inside of a bore 21 of the magnet 14, covering the whole of the inside surface of the bore; an electrically conductive fabric bag 72 wraps around a lower part of a patient; and a

curtain 75 of electrically conducting fabric is suspended over the open mouth of the magnet 14 at the end opposite to the patient (see Fig. 8).

As conceded in the Office Action, Hoult does not teach that a magnet itself comprises RF shielding. The Examiner states that this “mean[s] that there is no explicit recitation that the magnet has sufficient RF shielding in that it is a superconducting magnet with an inner diameter having a cryostat made of radio-opaque material.” Office Action, page 5. Palkovich is cited for allegedly teaching that “the magnet itself comprises RF shielding, meaning that the magnet has sufficient RF shielding in that it is a superconducting magnet with an inner diameter having a cryostat made of radio-opaque material.” *Id.* The Examiner asserts that it would have been obvious to one skilled in the art to modify Hoult with the teaching of Palkovich of “using his particular magnet arrangement with the cryostat in order to increase the RF shielding of the system.” *Id.*, citing Palkovich at column 6, lines 53-61.

Initially, Applicants would like to note for the record that the “meaning” of the claim language “magnet associated with magnet-RF-shielding” in the Office Action has been set out by the Examiner, and is not necessarily an interpretation agreed to by the Applicants. Further, Applicants do not concede the propriety of, and specifically reserve the right to present remarks addressing, any of the statements in the Office Action as to the alleged teachings, whether explicit or implicit, of the Hoult and Palkovich patents.

Applicants submit that one of ordinary skill in the art would not combine Hoult and Palkovich in the manner suggested in the Office Action, and that the Section 103(a) rejection of the present claims should therefore be withdrawn. The entirety of the Palkovich patent is directed explicitly toward magnetic shielding, not radio-frequency (RF) shielding. Specifically, Palkovich makes use of a hybrid (active and passive) magnetic shield shielding arrangement for a solenoid cryogenic magnet to effectively reduce the magnetic field generated by the magnet. The Examiner cites Palkovich as teaching a “four-fold increase of the shielding factor” (col. 6, line 60), but this is referring to a magnetic shielding factor. Nowhere in the Palkovich patent is there any mention of RF shielding, much less any recognition that a magnet itself can provide RF shielding in a system according to claim 1 of the present application.

Therefore, one of ordinary skill in the art, perceiving a deficiency in the Hoult patent with respect to RF shielding, would not look to the Palkovich patent, which relates to improvements in magnetic shielding, in order to achieve a substantially complete RF shield wherein the magnet itself is associated with magnet-RF-shielding. It is Applicants' own disclosure in the present application that teaches that a magnet is associated with RF-shielding in a system with a substantially complete RF shield. Neither Hoult nor Palkovich disclose this recitation or render it obvious.

Further, in contrast to the Examiner's assertions, Hoult does not disclose or render obvious a "holder" as recited in claim 1. As disclosed in Applicants' specification, the term holder "refers to a member that supports, and (in some embodiments) surrounds, a patient support unit, and in embodiments of the invention may comprise a bottom portion, a canopy, a patient end cap, and a base, as described in more detail below with reference to FIGS. 1, 1A, 1B and 1C." Applicants' specification, ¶ [0034]. The Examiner has taken the position that the electrically conductive fabric bag 72 of the Hoult patent discloses a "holder" as recited in claim 1. Office Action, page 4, citing Hoult at column 10, lines 15-50. However, the Hoult patent does not teach or suggest that the fabric bag 72 can hold or support a patient support unit, in distinct contrast to the "holder" of the subject invention. Moreover, the fabric bag 72 is not "adjoined to the cavity of a magnet" as recited in claim 1, but may only be electrically connected to a "suitable frame element" on the magnet 14 by a series of straps 74. Thus, the fabric bag 72 does not meet the limitations of the claimed invention.

The Examiner has taken the position that the layer 71 is a "magnet comprising magnet-RF-shielding." Office Action, page 4. However, according to the Hoult patent, the magnet 14 is "outside" the RF shield formed in part by the layer 71. The layer 71 may be applied to the inside of the bore 21, but the Hoult patent does not disclose or in any way indicate that the magnet 14 *itself* provides a portion of the RF shielding. Hoult thus fails to teach or render obvious a "magnet associated with magnet-RF-shielding," as recited in independent claim 1 of the present application.


The Examiner has also taken the position that with the disclosure of the layer 71 and the fabric bag 72, the Hoult patent teaches a magnet associated with magnet-RF-shielding that forms a substantially complete RF shield when the holder and magnet are combined. *Id.* However, the layer 71 and the fabric bag 72 do not form a substantially complete RF shield. As shown in Fig. 8 of the Hoult patent, any RF shielding formed when the fabric bag 72 is combined to the magnet apparatus would have at least two substantial gaps, and therefore would not be substantially complete, as recited in the present application claims.

For all of the reasons discussed above, independent claim 1 is patentable over the Hoult patent, and the Palkovich patent does not remedy Hoult's deficiencies. Applicants thus submit that the Section 103 rejection of the claims cannot properly be maintained. The dependent claims are also patentable by reason of their dependency from claim 1 and further due to the additional features that they recite.

In view of the above, the subject application is in condition for allowance. Favorable consideration and passage to issue of the application are respectfully requested.

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